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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/522,686	03/10/2000	Takaaki Nagae	1046.1211/JDH	5906

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EXAMINER

HILLERY, NATHAN

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/522,686

Applicant(s)

NAGAE, TAKAAKI

Examiner

Nathan Hillery

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7, 15, 23, 25 and 26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7, 15, 23, 25 and 26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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DETAILED ACTION

1. This action is responsive to communications: RCE filed on 10/31/05.
2. Claims 7, 15, 23, 25 and 26 are pending in the case. Claims 7, 15, 23 and 25 are independent.
3. The rejection of claims 7, 15, and 23 under 35 U.S.C. 103(a) as being unpatentable has been withdrawn as necessitated by amendment.

Continued Examination Under 37 CFR 1.114

4. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/31/05 has been entered.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 15, 23, 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson [SinaNet] (as previously cited) and further in view of Shinozaki (US 6119077 A).

7. **Regarding claims 7, 15, 23, 25 and 26**, Jackson teaches that *an internet company has developed a system that it claims can receive and read Chinese-language e-mail* (lines 1 – 2), compare with **receiving a sentence serving as contents of an electronic mail**. Jackson also teaches that *SinaNet has two coding standards for translating the characters, known as Big-5 for traditional and GB for simplified. A Big-5 user cannot read text generated by someone using GB and vice versa ... SinaNet's SinaXpress application has modules that translate between Big-5 and GB and make either format into a .GIF file for display on English-language browsers* (lines 23 – 28), compare with **a storing unit storing information in response to a destination of an electronic mail, the information indicating whether a sentence to be included in the electronic mail is text-displayable based on text data and a character code system used at the destination of the electronic mail; a transmission unit transmitting the electronic mail with the image data of the text file corresponding to the sentence to the destination of the electronic mail. Jackson does not explicitly teach a judging unit judging whether to form image data of a text file corresponding to the sentence based on the information stored in the storing unit; an image data forming unit forming the image data of the text file corresponding to the sentence when the judging unit judges that the image data of the text file corresponding to the sentence should be formed; a translation unit translating the sentence into a language used at the destination when the sentence is expressed by characters written in a language different from the language used at the destination of the electronic mail, the image data forming**

unit forming the translated image data of translation results expressed by characters written in the language used at the destination when the display control unit cannot text-display the characters written in the language used at the destination of the electronic mail; a synthesizing unit forming synthesized image data obtained by combining image data formed by the image data forming unit and corresponding to the input sentence with the translated image data, the synthesized image data including the image data of the sentence described by at least two lines and the translated image data of the translation results of the sentence inserted between the at least two lines, the transmission unit transmitting the synthesized image data to the destination of the electronic mail.

However, Aiba et al. teach that still another object of the invention is to provide an image communicating apparatus in which in case of transmitting code data, a function and a line state of an apparatus on the partner side are discriminated and, in accordance with the result of the discrimination, either one of a mode to directly transmit the code data and a mode to convert the code data into the image data and to transmit the converted image data is selected (Column 1, lines 59 – 66), and that since the telephone number has already been designated from the operation unit, the facility of the partner apparatus is judged from the telephone number stored in the backup memory 417 in a manner as mentioned in the first embodiment. When the partner apparatus doesn't have the developing facility of LIPS II, the data is transferred from the file unit 5 to the formatter 8 and is developed into the image and, after that, the image data is transmitted to the memory of the facsimile unit 4. When the partner apparatus

has the developing facility of LIPS II, the state of the line stored is subsequently judged. When it is determined that the data cannot be transmitted by the PDL due to the preceding information stored in the backup memory 417, the data is also developed into the image and the image data is transmitted (Column 16, line 55 – Column 17, line 2),

compare with a judging unit judging whether to form image data of a text file corresponding to the sentence based on the information stored in the storing unit. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Jackson with that of Aiba et al. because such a combination would allow the users of SinaNet (Jackson) the benefit of *an image communicating apparatus comprising a reader as an image input unit for inputting code data such as character code or the like* (Abstract, lines 1 – 3). Neither Jackson nor Aiba et al. explicitly teach **an image data forming unit forming the image data of the text file corresponding to the sentence when the judging unit judges that the image data of the text file corresponding to the sentence should be formed; a translation unit translating the sentence into a language used at the destination when the sentence is expressed by characters written in a language different from the language used at the destination of the electronic mail, the image data forming unit forming the translated image data of translation results expressed by characters written in the language used at the destination when the display control unit cannot text-display the characters written in the language used at the destination of the electronic mail; a synthesizing unit forming synthesized image data obtained by combining image data formed by the image data forming unit**

Art Unit: 2176

and corresponding to the input sentence with the translated image data, the synthesized image data including the image data of the sentence described by at least two lines and the translated image data of the translation results of the sentence inserted between the at least two lines, the transmission unit transmitting the synthesized image data to the destination of the electronic mail.

Shinozaki illustrates in Fig. 10 and teaches that *Another object of the present invention is to provide a translating machine which comprises a text inputting means for inputting an original text, text storage means for storing the original text inputted by the text inputting means, translating means for translating the original text inputted by the text inputting means, translation storage means for storing a translation obtained by the translating means, format information inputting portion for inputting format information for the original text and format information for the translation, format information storage means for storing the format information inputted by the format inputting means for the original text and the translation, synthesized information storing means for reading the original text format information and the translation format information from the format information storage means, adding the original text format information to the original text and the translation format information to the translation and storing a couple of the original text and the translation, and output means for outputting the synthesized information stored in the synthesized information storage means* (Column 1, lines 50 – 56), compare with **an image data forming unit forming the image data of the text file corresponding to the sentence when the judging unit judges that the image data of the text file corresponding to the sentence should be formed; a translation**

unit translating the sentence into a language used at the destination when the sentence is expressed by characters written in a language different from the language used at the destination of the electronic mail, the image data forming unit forming the translated image data of translation results expressed by characters written in the language used at the destination when the display control unit cannot text-display the characters written in the language used at the destination of the electronic mail; a synthesizing unit forming synthesized image data obtained by combining image data formed by the image data forming unit and corresponding to the input sentence with the translated image data, the synthesized image data including the image data of the sentence described by at least two lines and the translated image data of the translation results of the sentence inserted between the at least two lines, the transmission unit transmitting the synthesized image data to the destination of the electronic mail.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the inventions disclosed by Jackson, Aiba et al. and Shinozaki because such a combination would allow the users of SinaNet (Jackson) and the invention of Aiba et al. access to *a translating machine capable of presenting an original text and a translation with easy correspondence to each other* (Column 1, lines 47 – 49).

Response to Arguments

8. Applicant's arguments filed 10/31/05 have been fully considered but they are not persuasive.

9. In response to Applicant's arguments that Jackson is not an enabling reference, it should be noted that "Even if a reference discloses an inoperative device, it is prior art for all that it teaches." *Beckman Instruments v. LKB Produkter AB*, 892 F.2d 1547, 1551, 13 USPQ2d 1301, 1304 (Fed. Cir. 1989). Therefore, "a non-enabling reference may qualify as prior art for the purpose of determining obviousness under 35 U.S.C. 103." *Symbol Techs. Inc. v. Opticon Inc.*, 935 F.2d 1569, 1578, 19 USPQ2d 1241, 1247 (Fed. Cir. 1991). (MPEP 2121.01)

10. In response to applicant's argument that Aiba is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, Aiba is in the field of applicants endeavor, since Aiba teaches that *The present invention relates to an image communicating apparatus and, more particularly, to an image communicating apparatus having a transmitting function of code data formed by a computer or the like* (Field of Invention). Furthermore, the motivation to combine Aiba with Jackson is that Aiba teaches *an image communicating apparatus comprising a reader as an image input unit for inputting code data such as character code or the like* (Abstract, lines 1 – 3).

11. In response to applicant's arguments against the references individually (Aiba has nothing to do with translation of an electronic message (p 6, second paragraph)), one cannot show nonobviousness by attacking references individually where the

Art Unit: 2176

rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Moreover, The Office maintains that the combination of Jackson and Aiba teach, suggest and/or disclose **a judging unit judging whether to form image data of a text file corresponding to the sentence based on the information stored in the storing unit**, since Aiba teaches that *an image communicating apparatus comprising a reader as an image input unit for inputting code data such as character code or the like* (Abstract, lines 1 – 3) and as claimed **a storing unit storing information in response to a destination of an electronic mail, the information indicating whether a sentence to be included in the electronic mail is text-displayable based on text data and a character code system used at the destination of the electronic mail.**

12. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

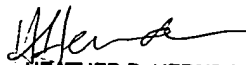
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Hillery whose telephone number is (571) 272-4091. The examiner can normally be reached on M - F, 10:30 a.m. - 7:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather R. Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

NH


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